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W. Todd Daniell

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AT&T Legal Department

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EXAMINER

LAI, MICHAEL C

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/686,429	Applicant(s) DANIELL, W. TODD	
	Examiner MICHAEL C. LAI	Art Unit 2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to amendment filed on 9/24/2008.

Response to Amendment

The examiner has acknowledged the new claims 13-19.

Response to Arguments

Applicant's arguments filed 9/24/2008 have been fully considered but they are not persuasive.

Applicant's arguments, see pages 6-9, with respect to “each indicator corresponding to a user in the predefined group of users, each indicator being configured to indicate whether the corresponding user has **acted** upon the group email message”, is not persuasive. Hickey discloses a group electronic mailbox with a status indicator for each group email message received by a member in the group (see Figure 6 second column 143B and paragraph 0063). Hickey further teaches a status indicator for the group electronic mailbox in which the indicator is updated when a member of the group causes a change in status. A change in status occurs when a member has **acted** upon the information by either **reading, replying**, etc. the information within the group email box (see paragraph 0043, particularly lines 7-12, “read information, acted upon information, and replied information”). As such, Hickey is not just limited to changing the status indicator by accessing the email but also by **reading, replying**, etc. to the group email messages which are considered as **acts** upon the email message by a member of the group. Therefore Hickey meets applicant limitation of the claim “each indicator corresponding to a user in the predefined group of users, each indicator being

configured to indicate whether the corresponding user has **acted** upon the group email message”.

Applicant's arguments, see pages 9-10, with respect to claims 2-9 and 11-19, are not persuasive. See reasons above.

Thus, in view of such, the rejection is sustained as follows:

Claim Objections

1. Claim 18 is objected to because of the following informalities: “claim 1” in line 1 should be “claim 13.”
2. Claim 19 is objected to because of the following informalities: “claim 1” in line 1 should be “claim 13.” Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 13-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13-19 recite the limitation of “computer readable medium...” that is described in page 34, second paragraph of the original specification as “a “computer-readable medium” can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium.” As such, the

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claims would fairly suggest to one of ordinary skill signals or other forms of propagation and transmission media to be an appropriate manufacture under 35 USC 101 in the context of computer-related inventions.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, and 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey et al. (US 2002/0087646 A1, hereinafter Hickey).

Regarding claim 1, Hickey teaches a communication system comprising:

a client-side group email folder accessible by each user in a predefined group of users (FIG. 3 and para. 0037); and

a group email message in the client-side group email folder, the group email message having indicators, each indicator corresponding to a user in the predefined group of users, each indicator being configured to indicate whether the corresponding user has acted upon the group email message, wherein the group email message is stored in a common database such that users of the group have access to the group email message via the database (FIG. 3 and para. 0010, 0021, 0043, 0057).

Hickey discloses substantially all the limitations including the idea that users will each typically have an individual mailbox as well as access to group electronic

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mailbox. Users can electronically communicate with one another by exchanging e-mail messages over the network through individual e-mail mailboxes and group electronic mailbox 25 (see FIG. 2 and para. 0036). However, Hickey fails to disclose the option to view at least one user-specific email, the user-specific email being different than the group email message. It would be obvious to one skilled in the art at the time of the invention was made to recognize that Hickey's teaching is at least functionally equivalent to the claimed invention based on the cited portion above for the purpose of achieving the same end result.

Regarding claim 2, Hickey teaches the system of claim 1, wherein each indicator comprises a first setting, the first setting indicating that the group email message has not been acted upon by the corresponding user (para. 0079, New).

Regarding claim 3, Hickey teaches the system of claim 2, wherein each indicator further comprises a second setting, the second setting indicating that the group email message has been acted upon by the corresponding user (para. 0043, acted upon information.).

Regarding claim 4, Hickey teaches the system of claim 1, wherein each indicator is further indicative of whether the corresponding user has selected the group email message (para. 0063, first column 143A).

Regarding claim 5, Hickey teaches the system of claim 1, wherein each indicator is further indicative of whether the corresponding user has opened the group email message (para. 0079, Read, Answered, Moved, etc.).

Regarding claim 6, Hickey teaches the system of claim 1, further comprising a second indicator indicative of whether the corresponding user has deleted the group email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Regarding claim 7, Hickey teaches the system of claim 1, further comprising means for indicating whether a user has deleted the group email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Regarding claim 9, Hickey teaches the system of claim 1, wherein each user represents a unique individual (para. 0051, lines 6-9).

Regarding claim 10, Hickey teaches a communication method comprising:

providing indicators in a group email message, the group email message being located in an inbox, each indicator corresponding to one of the users in a predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message (para. 0060, step 138 and para. 0061, step 140); and

changing the setting of one indicator in response to the email message being acted upon by its corresponding user (para. 0064), wherein the group email message is stored in a common database such that users of the group have access

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to the group email message via the database (FIG. 3 and para. 0010, 0021, 0043, 0057).

Hickey discloses the claimed invention except for the option to view at least one user-specific email, the user-specific email being different than the group email message. However, Hickey also teaches that users will each typically have an individual mailbox as well as access to group electronic mailbox. Users can electronically communicate with one another by exchanging e-mail messages over the network through individual e-mail mailboxes and group electronic mailbox 25 (see FIG. 2 and para. 0036). It would therefore be obvious to one of ordinary skill in the art at the time of the invention was made to combine Hickey's teachings for the purpose of avoiding the hassle of jumping between group email messages and user-specific email messages by providing an email interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message, thereby providing a more user-friendly and more productive environment.

Regarding claim 11, Hickey teaches the method of claim 10, wherein providing indicators comprises providing read indicators, each read indicator corresponding to one user in a predefined group of users, each read indicator being configured to indicate whether its corresponding user has read the email message (para. 0079, Read).

Regarding claim 12, Hickey teaches the method of claim 10, wherein providing indicators comprises providing delete indicators, each delete indicator corresponding to one user in a predefined group of users, each delete indicator being configured to indicate whether its corresponding user has deleted the email message. each delete indicator being configured to indicate whether its corresponding user has deleted the email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Claim 13 is of the same scope as claim 10. It is rejected for the same reason as for claim 10.

Claim 14 is of the same scope as claim 11. It is rejected for the same reason as for claim 11.

Claim 15 is of the same scope as claim 12. It is rejected for the same reason as for claim 12.

Claim 16 is of the same scope as claim 4. It is rejected for the same reason as for claim 4.

Claim 17 is of the same scope as claim 5. It is rejected for the same reason as for claim 5.

Claim 18 is of the same scope as claim 7. It is rejected for the same reason as for claim 7.

7. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey, in view of Stark et al. (US 2003/0233420 A1, hereinafter Stark).

Regarding claim 8, Hickey teaches the system of claim 1, but fails to disclose wherein the indicator is an extensible markup language (XML) tag corresponding to

a user in the predefined group. However, Stark shows embedded XML tags that describe certain attributes of messages [Page 3, Para. 0035]. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Stark into Hickey's system to use XML tag for the indicator corresponding to a user in the predefined group. The motivation would be taking the advantage of the widely accepted language of e-commerce (XML).

Claim 19 is of the same scope as claim 8. It is rejected for the same reason as for claim 8.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are

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applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Lai whose telephone number is (571) 270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai

16OCT2008

/Yves Dalencourt/
Primary Examiner, Art Unit 2457